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Patent and Trademark Office**

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APPLICATION NUMBER

FILING DATE

FIRST NAMED APPLICANT

ATTORNEY DOCKET NO.

09/269,587 12/06/99 MILLER

EXAMINER

5 4387017004

TM02/1015

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ART UNIT

PAPER NUMBER

LUU, L

DATE MAILED:

2152

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

10/15/01

**OFFICE ACTION SUMMARY**

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

1. Claims 1-20 are presented for examination.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11 and 13-20 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Nakanura patent no. 5,548,789.

4. As to claim 1, Nakanura teaches a method of receiving e-mail, said e-mail including a header and a message body, comprising the steps of:

separating said header from said message body (col. 7 lines 45-67, message header and message body are separated);

storing said message body in a message body field (col. 7 lines 45-67, message header and message body store in different memories);

separating information contained in said header into a plurality of header information fields (col. 9 lines 51-64);

storing said header information fields (col. 9 lines 8-20, col. 9 lines 51-64, message control table has message areas for storing names of sender, receiver, etc.);

linking at least one of said plurality of header information fields with at least a second of said plurality of header information fields or message body field (col. 8 line 60- col. 9 line 20); and

creating a plurality of relationship fields for storing information sufficient to identify said link between said at least one header information field and said at least second header information field or message body field (col. 8 line 60- col. 9 line 20).

5. As to claims 2-11, 13-16, Nakanura teaches header information fields, relationship fields are stored as tables, fields for identifying message body, information for linking said header information fields and said relationship fields and said message body, multiple e-mails, email message number (col. 8 line 60- col. 9 line 20).

6. As to claims 17-20, they are related to receiving a message and have similar limitations as claims 1-4; therefore, the discussion above is applied.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 12 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Nakanura** patent no. **5,548,789**, in view of **Scannell et al (Scannell)** patent no. **5,377,354**.

9. As to claim 12, Nakanura teaches the invention substantially; however, Nakanura does not explicitly teach prompting an e-mail recipient whether to save or delete a second email message if the sender e-mail information is not identical to information stored in said plurality of header information fields. Scannell teaches applying a set of rules to incoming message before appropriate action is taken, and the rules uses various header fields (col. 3 line 50 - col. 4 line 4, col. 5 line 26 - col. 7 line 8). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Nakanura and Scannell to automatically scans received message and prompt recipient for further actions because it would allow user to have more control whether to keep the received e-mail message or not.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu, whose telephone number is (703) 305-9650. The examiner can normally be reached Monday through Friday from 7:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached at (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 746-7239, (for **formal communications**; please mark  
"EXPEDITED PROCEDURE").

**Or:**

(703) 746-7240 (for **informal or draft communications**, please  
label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

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A handwritten signature in black ink, appearing to read 'Le Hien Luu', with a horizontal line drawn underneath it.

LE HIEN LUU  
PRIMARY EXAMINER

October 10, 2001